

Title: GOLF CLUB AND METHOD OF MANUFACTURING

Serial No. 10/766,400

Amendment

REMARKS

Claims 1-23 were pending in the application. Claims 1-10, 15-19 and 22 are cancelled by this amendment as directed to a non-elected invention. Accordingly, claims 11-14, 20-21, and 23 are currently pending in the application.

Claims 11-12, 20-21 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,624,330 to Tsuchida. Applicants have amended claims 11 and 20 to overcome the rejection.

Claim 11 has been amended to include a specific limitation that the radial crush sleeve is disposed fully within the hosel bore. Tsuchida discloses a golf club in which the shaft is secured to the golf club head by a combination of an adhesive layer (6) and a ferrule (7) that snap-fits into a recess formed in the hosel bore (3). A ferrule, however, must extend out of the hosel bore in order to serve its function of reinforcing the joint between the shaft and the hosel bore (and secondarily providing an aesthetically pleasing contour). Because the ferrule disclosed in Tsuchida extends out of the hosel bore, Tsuchida does not disclose a radial crush sleeve that is disposed fully within the hosel bore. Accordingly, Tsuchida does not anticipate claim 11 as amended.

Claim 20 has similarly been amended to include the limitation that the radial crush sleeve is completely concealed by the joint between the golf club shaft and the hosel of the golf club. Again, because the ferrule disclosed in Tsuchida extends out of the hosel bore, Tsuchida does not disclose a radial crush sleeve that is completely concealed by the joint between the golf club shaft and the hosel of the golf club head. Accordingly, Tsuchida does not anticipate claim 20 as amended.

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Claim 13 stands rejected under 35 U.S.C. § 103(a) as being obvious considering Tsuchida in view of U.S. Patent No. 6,352,482 to Jacobson. Applicants believe the amendments to claim 11, from which claim 13 depends, are sufficient to overcome the rejection. As noted above, Tsuchida discloses a golf club in which the shaft is secured to the golf club head by a combination of an adhesive and a ferrule that snap-fits into a recess formed in the hosel bore. Since, by definition, a ferrule must extend out of the hosel bore in order to serve its function of reinforcing the joint between the shaft and the hosel bore, Tsuchida does not disclose or suggest a golf club including a radial crush sleeve that is disposed fully within the hosel bore. Similarly, Jacobson itself discloses a hosel liner (50) that includes a ferrule portion (64) that extends out of the hosel bore. Accordingly, there is no motivation for combining Tsuchida with Jacobson to arrive at a golf club that includes a radial crush sleeve that is disposed fully within the hosel bore having an undercut region that is at least .040 inches greater than the major diameter of the hosel bore as claimed in claim 13 as amended. It is well settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive in the prior art supporting the combination. *In Re Geiger*, 815 F.2d, 686, 688 (Fed. Cir. 1987); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984).

Moreover, since the purpose of a ferrule is to reinforce a joint by decreasing the stress concentration that would otherwise occur at the point where the golf club shaft enters the hosel, any combination of references that included a radial crush sleeve that was fully within the hosel would render the invention disclosed in Tsuchida unsuitable for its intended purpose because the ferrule would no longer perform its essential stress reduction function. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then

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there is no suggestion or motivation to make the proposed modification and a rejection based on such a proposed combination is improper. MPEP 2143.01; In Re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Accordingly, for this additional reason, applicants believe the amendment to claim 11 renders claims 11-14 allowable over the art of record.

Claim 14 stands objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Applicants believe that claim 11 is now allowable and, therefore urge claim 14 be allowed as written in its dependent form.

Conclusion

No new matter is introduced by the amendments herein. Support for the amendments to claims 11 and 20 is found in the specification, including FIGs. 2 and 5. Support for the amendment to claim 13 is found in the specification at pages 6-7. Based on the foregoing, applicants believe that all claims under consideration are in a condition for allowance and reconsideration of this application is respectfully requested.

Respectfully submitted,

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